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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,836	12/21/2000	Edward O. Clapper	42390P10784	8616

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TROP PRUNER & HU, PC
8554 KATY FREEWAY
SUITE 100
HOUSTON, TX 77024

EXAMINER

TIEU, BINH KIEN

ART UNIT PAPER NUMBER

2643

DATE MAILED: 09/16/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,836

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28 and 30-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28, 30-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34, 36, 40 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Snyder et al. (U.S. Pat. 5,784,444 as cited in the previous Office Action).

Regarding claim 34, Snyder et al. ("Snyder") teaches a telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figure 6) to replace the caller ID value for the telephone at which the calling card is used (col.4, lines 47-67).

Regarding claim 36, note col.4, lines 64-67.

Regarding claim 40, Snyder et al. ("Snyder") teaches a telephone calling card comprising:

a memory having stored therein a plurality of predetermined messages (i.e., messages: ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figure 6), one or more of said plurality of messages to be received by a recipient communications devices in place of the respective caller ID value of a telephone at which the calling card is used (col.4, lines 47-67 and col.5, lines 16-32).

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Regarding claim 42, note col.4, lines 53-56 and lines 65-67.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action) in view of Snyder et al. (U.S. Pat. #: 5,784,444).

Regarding claim 28, Tasaki et al. ("Tasaki") teaches a telephone calling card comprising:
a memory having stored therein a unique identifying value (i.e., calling account number, card data, etc.), said memory having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, the respective telephone number to be stored in the memory at a time later than the manufacturing of a calling card (col.1, line 48 – col.2, line 16).

It should be noticed that Tasaki fail to clearly teach said memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. However, Snyder et al. ("Snyder") teaches a plurality of predetermined messages such as messages of ICLIDTO number 208, indicia 210 and/or short message 212 as shown in figures 6 and 6A for a purpose of identifying caller by called party.

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Therefore, it would have been obvious to one of ordinary skilled in the art the time the invention was made to incorporate the use of such memory stored therein a plurality of predetermined messages, as taught by Snyder, in view of Tasaki, in order to establish a calling card communication with the caller.

Regarding claim 30, Snyder further teaches limitations of the claim as shown in pictures 6 and 6A, col.4, lines 47-53 and col.5, lines 16-32.

Regarding claim 31, Tasaki further teaches limitations of the claim in col.1, lines 53-58.

Regarding claim 32, Snyder further teaches limitations of the claim in col.4, lines 57-56.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tasaki et al. (U.S. Pat. #: 4,879,744) in view of Snyder et al. (U.S. Pat. #: 5,784,444) as applied to claim 28 above, and further in view of Taskett (U.S. Pat. #: 5,923,734 also cited in the previous Office Action).

Regarding claim 33, Tasaki and Snyder, in combination, teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or

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messages printed on the card, as taught by Taskett, into view of Tasaki and Snyder in order to distinguish the message card with other standard calling cards.

6. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. (U.S. Pat. #: 5,784,444) in view of Taskett (U.S. Pat. #: 5,923,734).

Regarding claim 35, Snyder teaches all subject matters as claimed above, except for said plurality of predetermined messages being printed on the card. However, Taskett teaches a prepaid card or phone card having visual indicia on one or both sides of the card. While connected to the service provider network, audio indicia relating to the visual indicia on the prepaid instrument is suitably communicated to the consumer at appropriate times or intervals (see Abstract, col.5, lines 15-45 and col.6, lines 47-53) for a purpose of improving a distributed system for effecting commercial telephone card transactions by a consumer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of teachings of the prepaid phone card imprinted with a visual indicia associated with corresponding audio indicia as predetermined message or messages printed on the card, as taught by Taskett, into view of Snyder in order to distinguish the message card with other standard calling cards.

Regarding claim 36, Snyder further teaches limitations of the claim in col.4, lines 53-56.

7. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. (U.S. Pat. #: 5,784,444) in view of Tasaki et al. (U.S. Pat. #: 4,879,744 as cited in the previous Office Action).

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Regarding claim 37, Snyder further teaches the well-known billing format of the calling card (col.4, lines 25-32). Snyder, however, fails to clearly teach said calling card comprising said memory has a storage area therein for holding a value specifying an account balance, the account balance being stored in the memory at a time later than the manufacturing the calling card. Tasaki et al. ("Tasaki") teaches such features in col.1, lines 53-58, col.3, lines 39-46 and col.4, lines 26-32, line 2 for a purpose of allowing caller to make calls without carrying coins or cash. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the memory of the calling card having a storage area therein for holding a value specifying a respective telephone number which is to be called upon usage of the calling card, as taught by Tasaki, in view of Snyder in order to use the telephone card as a substitute for cash payment.

Regarding claim 38, note col.1, lines 48-52 and col.1, line 64 – col.2, line 2.

Regarding claim 39, note col.1, line 64 – col.2, line 2.

8. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder et al. (U.S. Pat. #: 5,784,444) in view of Tasaki et al. (U.S. Pat. #: 4,879,744).

Regarding claim 41, Snyder teaches all limitations as claimed above, except for the feature of said memory has a storage area therein for holding a value specifying a respective telephone number that is to be called upon usage of the calling card. However, Tasaki teaches such feature in col.1, line 64 – col.2, line 16 for a purpose of eliminating the labor of manual dialing.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of such memory of the card, as taught by Tasaki, into view of Snyder in order to eliminate the labor of manual dialing and quickly establish of a communication.

Response to Arguments

9. Applicant's arguments filed August 01, 2003 have been fully considered but they are not persuasive.

A/. In response to the Applicant's arguments in the third paragraph, page 2 under his REMARKS/ARGUMENTS section wherein the Applicant stated as following:

“ Snyder does not teach replacing the caller ID value or receiving a predetermined message in place of a caller ID value. Rather, Snyder teaches supplemental a caller ID value...”

The Examiner respectfully disagrees with the Applicant arguments as stated above. first of all, the Examiner carefully read the specification wherein in the second paragraph, page 5 discloses the user provides her personal identification number (PIN) for the security of using her credit card by “...swiping her calling card through the phone's credit card slot...”, the specification further discloses in the third paragraph, page 7 that a “message card” may be pre-programmed to contain message such as “I love you” or “I have left the office, home soon” to send to destination phone whenever the message card is swiped through the card reader. This kind of use of the message(s) stored on the message card is to provide additional caller ID value to the destination phone. Lastly, the specification teaches, in the first and second paragraph, page 8, a method of operating a system in conjunction with the message card. In these

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paragraphs, the card stored at least one fixed message. When it is swiped through a reader, the fixed message(s) is/are displayed to user for selection. If a message is selected, the selected message is then sent to the destination communication device as supplementing a caller ID value. The examiner see nowhere in the specification discloses the feature that the stored messages are used for substitution in place of the respective caller ID value of telephone at which the calling card is used. The Examiner agrees that the specification discloses the message card to be pre-programmed to store messages to be sent to destination communication device as supplemental caller ID value. The Examiner does not agree that such stored messages are used for substitution in place of the respective caller ID value of telephone at which the calling card is used. Therefore, the Applicant is required to point out wherein the specification provides the feature of using such stored messages in the telephone calling card for substitution in place of the respective caller ID value of telephone at which the calling card is used. Examiner, therefore, assumed and examed the limitations of claimed invention based on the disclosure of the specification, that is, "supplementing a caller ID value" as set forth in the previous Office Action as well as in this Office Action.

B/. In response to the Applicant's arguments in the first and second paragraph, page 3 wherein the Applicant stated as following:

"... In dependent claim 28 calls for a memory having stored therein a predetermined message for substitution in place of the respective caller ID value...However, as explained above, neither does Snyder. Thus, the combination of Tasaki and Snyder does not teach each and every limitation as required to render claims 28, 30-32 unpatentable."

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The Examiner respectfully disagrees with the Applicant's arguments above. Since Applicant argued the same features that Snyder fails to teach, Applicant should be referred to the Examiner's response as explained above.

C/. In response to the Applicant's arguments in the third paragraph, page 3 wherein the Applicant stated as followings:

“Further, there is no suggestion, motivation or teaching of the desirability to make the specific combination made by the Applicant. Without the suggestion, motivation or teaching of the desirability of making the claimed invention, even if all claim parts...”

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references disclosed cards for use in conjunction of making telephone card calls. Both references are capable to store information data onto the cards. Therefore, according to those skilled in the art to release that they are well combined to each other.

With all responses to the Applicant's arguments raised in his Remarks/Arguments section as discussed above, the Examiner believes that rejections to the claims as set forth in the previous Office Action, as well as in this Office Action have been proper and permissible in the merits. Therefore, the Examiner has maintained the rejections as well as his responses to all Applicant's arguments as explained above in this Office Action.

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Any response to this final action should be mailed to:

Box AF

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

**(703) 872-9314 (for formal communications; please mark
"EXPEDITED PROCEDURE")**

Or:

**If it is an informal or draft communication, please label
"PROPOSED" or "DRAFT")**

Customer Service (703) 306-0377

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN**

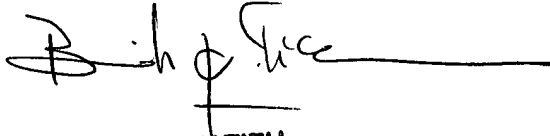
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Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.

A handwritten signature in black ink, appearing to read "Binh Tieu", with a long horizontal line extending to the right.

**BINH TIEU
PRIMARY EXAMINER**

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Date: September 08, 2003